

REMARKS

Claims 1 through 11 are pending in this Application. Claims 5, 6 and 7 have been amended to delete the word “discretionarily”. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 6 and 7 were rejected under the first paragraph of 35 U.S.C. § 112 for lack of adequate enabling support.

In the statement of the rejection the Examiner asserted the lack of enablement for “discretionarily” selecting peak wavelengths. This rejection is traversed.

Firstly, lack of enablement is a legal conclusion. In order to support that legal conclusion the Examiner must begin with a presumption that the specification is enabling, unless the Examiner can establish that the written description suggests an inherently unbelievable undertaking or involves implausible scientific principles. *In re Cortright*, 165 F.3d1353, 49 USPQ2d 1464 (Fed. Cir. 1999); *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). No such facts have been established. Simply put, the mere conclusory statement that a specification lacks enablement is not sufficient to generate a *prima facie* basis to deny patentability to the claimed invention.

At any rate in order to expedite prosecution, the word “discretionarily” has been deleted from claims 5, 6 and 7, thereby overcoming the stated basis for the imposed rejection. Accordingly, withdrawal of the rejection of claims 6 and 7 under the first paragraph of 35 U.S.C. § 112 for lack of adequate enabling support is solicited.

Claims 6 and 7 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner asserted that the claims are indefinite by virtue of the “discretionarily selected” language. This rejection is traversed.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. Further, the Examiner bears the initial burden of providing a basis of establishing that one having ordinary skill in the art would not have understood the scope of the claimed invention when reasonably interpreted in light of and consistent with the written description of the specification. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993). Indeed, and quite significantly, the test for whether a claim is indefinite is whether it is insolubly ambiguous such that no narrowing construction can properly be adopted, regardless of how formidable a task it is to understand the claim. *Invitrogen Corp. v. Biocrest Manufacturing L.P.*, ____ F3d ____, 76 USPQ2d 1741 (Fed. Cir. 2005); *Exxon Research & Eng'g. Co. v. United States*, 265 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001).

The burden of establishing indefiniteness has not been discharged. Accordingly, a *prima facie* basis to deny patentability to the claimed invention under the second paragraph of 35 U.S.C. § 112 has not been established.

At any rate, in order to expedite prosecution, the language “discretionarily” has been deleted from claims 5, 6 and 7, thereby overcoming the stated basis for the imposed rejection. Accordingly, withdrawal of the rejection of claims 6 and 7 under the second paragraph of 35 U.S.C. § 112 is solicited.

Claims 1 through 4, 6 through 8, 10 and 11 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Bolshtyansky et al.

In the statement of the rejection the Examiner referred to Figs. 2 and 3 of Bolshtyansky et al. and to various portions of the patent text, asserting the disclosure of a module, broadband light source, and amplifier corresponding to those claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a significant difference between the claimed inventions and the device disclosed by Bolshtyansky et al. that scotches the factual determination that Bolshtyansky et al. discloses a module, broadband light source, and amplifier identically corresponding to those claimed.

Specifically, the device defined in each of independent claims 1, 10 and 11 comprises, *inter alia*, “a nonlinear medium”. In this respect, Applicant would note that optical fiber 52 of the device disclosed by Bolshtyansky et al., is **not**, repeat **not**, disclosed as a **nonlinear** medium. **Silence** in a reference is no substitute for the requisite facts. *In re Burt*, 356 F.2d 115, 148 USPQ 548 (CCPA 1966).

Not only does Bolshtyansky et al. fail to disclose that optical fiber 22 is a nonlinear medium, it should be apparent from Fig. 4 that the output light from fiber 52 is illustrated as a multi wavelength pump that has four separate wavelengths (light λ 1, λ 2, λ 3 and λ 4).

The above argued difference between the claimed inventions and the device disclosed by Bolshtyansky et al. undermines the factual determination that Bolshtyansky et al. discloses a module, broadband light source and amplifier identically corresponding to those claimed.

Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claims 1 through 4, 6 through 8, 10 and 11 under 35 U.S.C. § 102 for lack of novelty as evidenced by Bolshtyansky et al. is not factually viable and, hence, solicits withdrawal thereof.

Claims 5 and 9 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Bolshtyansky et al. in view of Agrawal.

This rejection is traversed.

Firstly, claims 5 and 9 depend from independent claim 1. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Bolshtyansky et al. The secondary reference to Agrawal does not cure the previously argued deficiencies of Bolshtyansky et al.

Moreover, the separate patentability of claims 5 and 9 is advocated. Specifically, Bolshtyansky et al. neither disclose nor suggest the notion of spreading a wavelength band of the light from a light source system and using the light as a pump for a Raman amplifier.

The Examiner's reliance upon "routine mathematical calculations" does not establish the requisite factual basis upon which to conclude that one having ordinary skill in the art would have been realistically motivated to modify the **particular** device disclosed by Bolshtyansky et al. to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir.

Application No.: 10/699,846

2002); Ecolochem Inc. v. Southern California Edison, Co., 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); In re Kotzab, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

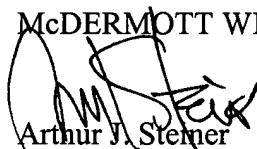
Applicant, therefore, submits that the imposed rejection of claims 5 and 9 under 35 U.S.C. § 103 for obviousness predicated upon Bolshtyansky et al. in view of Agrawal is not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:bjs:ntb
Facsimile: 202.756.8087
Date: **January 17, 2006**

**Please recognize our Customer No. 20277
as our correspondence address.**